

DETAILED ACTION

Receipt of response to election requirement dated 8-10-09 and IDS dated 11-15-08 is acknowledged.

Claims 1-8 and 12-16 are pending in the instant application. Claims 9-11 and 17 have been canceled. The dependencies of claims 12-13 have been changed to claim 1 and applicants canceled the claims directed to a process. Hence all claims 1-8 and 12-16 have been considered for further consideration.

Claim Rejections - 35 USC § 112

1. Claims 1-8 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claim 1 fails to recite to what the instant composition is applied, which renders the claim vague and indefinite. Claims 2-8 and 12-16 are dependent on claim 1 and hence rejected.

Claim 12 recites the terms "low degree of polymerization" and "high degree of polymerization", which is vague and indefinite because applicants have not described in the instant specification as to what is construed as a "high" or "low" degree of polymerization.

Examiner notes that claim 16 spelled the word "chymotrypsin" as "chymotrypsin".

2. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claim 12 recites that the active material obtained from chestnut meal should contain three glucide fractions: 1) Polysaccharide fraction: rhamnogalacturonan, 2) Oligosaccharide fraction with a high degree of polymerization and free uronic acids, and 3) A mono- and oligosaccharide fraction of a low degree of polymerization.

3. A review of the instant specification does not provide a written description of what types or kinds of polysaccharides or oligosaccharides are present in the chestnut meal, claimed in the instant claim 12. Instant claims as well as the disclosure only vaguely state, 2) Oligosaccharide fraction with a high degree of polymerization and free uronic acids, and 3) A mono- and oligosaccharide fraction of a low degree of polymerization. Applicants have provided no information as to what degree of polymerization is high or low. This, together with the lack of any particular oligosaccharides or polysaccharides in the specification does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed method of treatment with the claimed chestnut meal having the requirements of claim 12.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 12, 13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,170,916 to Dziengel et al (Dziengel) and further as evidenced by Van der Haar.

6. Dziengel discloses a method of producing durable saponin containing extracts from chestnuts and products obtained therefrom. It is suggested that while the extracts of chestnuts have long been known for their therapeutic and cosmetic effects, restricting the water content of the meal improves the skin diffusion (col. 4, L 31-47). Dziengel teaches that the composition is useful for tightening of skin, acne, blemishes etc (col. 2, L 5-16). The process involves extracting an active agent from the chestnut using solvents such as propylene glycol (col. 2, L 19-30), particularly for saponines, flavanols etc. Instant claims do not state what the active agent is and hence can include the active agent of Dziengel. With respect to the activities or the specific use claimed in each of the claims 3-7, while Dziengel does not mention the claimed uses, neither the instant specification nor instant claims state what the actual ingredient is that enables the claimed effect. On the other hand, Dziengel teaches extraction of chestnut meal and therefore it is the position of the examiner that the active agents in the chestnut meal of the Dziengel possess the claimed uses of instant claims 3-7. The dry content of the

extract is 15-25 grams dry weight (col. 3, L 7-11). The composition of Dziengel is combined with other components employed in cosmetic compositions and applied as packs, embrocations and otherwise (col. 4, L 48-50). With respect to the sugar content of claim 13, while Dziengel does not state the amount of sugar, Van de Haar (abstract of the article on Saponins, 1923) shows that hydrolysis of chestnut seed saccharides result in about 23% glucose, and other sugars such as pentose, galactose, glucuronic acid etc. Thus, it is the position of the examiner that the chestnut meal of Dziengel contains sugars in the claimed range and the burden is on applicants to show otherwise. While Dziengel is silent regarding the pH of the extract, it is the position of the examiner that the chestnut meal of Dziengel would inherently possess the claimed pH because the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Thus, Dziengel anticipates instant claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,170,916 to Dziengel et al (Dziengel) and further as evidenced by Van der Haar, in view of US 4,800,080 to Grollier et al.
9. Instant claim requires that the cosmetic composition is in the form of an aqueous emulsion, an alcoholic emulsion, a lotion, a cream with an aqueous base, a cream with a fatty base, and an ointment. Dziengel fails to disclose the claimed forms.
10. Grollier teaches cosmetic compositions comprising saponins extracted from various plant materials including chestnuts (col. 3, L 14-21). Grollier suggests that the composition containing the above chestnut and other plant extracts may be in the form of lotions or gels in the form of aqueous or aqueous alcoholic extracts (col. 10, L 14-22). Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to prepare a cosmetic composition with the chestnut extract of Dziengel, in a suitable form such as emulsion which is aqueous or alcoholic with an expectation to provide the maximum availability of the active ingredient in chestnut extract from the preparation when applied to skin for its desired properties (moisturizing suggested by Dziengel or conditioning property suggested by Grollier).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
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